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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,025	10/28/1999	HAROLD L. PETERSON	M5386-02	6247

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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 12/17/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/423,025

Applicant(s)

PETERSON ET AL.

Examiner

Kambiz Abdi

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-25 have been examined.
2. Information Discloser Statement (IDS) received on October 28, 1999 has been included in the application.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/US98/18948, filed on 9/11/1997.

Drawings

4. The drawings are objected to because figures 1-11 are none descriptive. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-25 are rejected under 35 U.S.C. 102 (e) being anticipated by Ronald J. Subler, U.S. Patent No. 5,646,992.

As per claim 1, Subler discloses;

communicating over a communications medium; (see column 4, lines 38-65) and storing at the personal computer (see column 4, lines 59-61 and column 16, lines 26-32) an inventory of assets which are instances of the digital content, wherein each said asset is protected from unauthorized use by a digital wrapper requiring at least one key for unwrapping, (see column 2, lines 22-28, wherein the Subler discloses a plurality of encrypted digital assets stored within the workstation able to communicate with a central order taking system),

displaying on the personal computer information about said inventory, accepting from a user of the personal computer a selection representing a particular said asset, (see column 1, lines 31-38 and see column 3, lines 45-52)

transmitting money representing payment for said selection and an identifier associated with said selection, via said communications means, (see column 2, lines 59-62, column 3, lines 32-32, and column 4, lines 56-64, wherein the order may also include information which is unique to the particular workstation being used and assures that the acknowledgment returned in response to the order will permit use of the items only on the particular workstation. The order may be delivered to the order taker under program

control (e.g., via FAXmodem, modem, network packet, or cable system) or under user control (e.g., via voice telephone call, FAX, or printed matter) Subler reference corresponds to above limitations.),

receiving all said keys required for unwrapping said selection, via said communications means, and (see column 14, lines 40-49),

unwrapping said digital wrapper protecting said selection; and receiving said money and said identifier from the personal computer, via said communications means, (see column 2, lines 59-62) and transmitting one said key associated with said selection back to the personal computer (see column 2, lines 21-27).

7. Regarding claim 2, Subler discloses receiving said one said key as a first said key, via said communications means; and (see column 2, lines 59-63) transmitting a second said key back to the personal computer, wherein both said first said key and said second said key are together required to unwrap said digital wrapper protecting said selection. (see column 9, lines 65-67, and column 10, lines 1-11, wherein Subler reference describes the well known multiple key encryption/decryption scheme that corresponds to the above limitations).

8. Regarding claim 3, Subler anticipates an order taking systems (Clearing House) or publishers, wherein said master server means is further for

transmitting updates to said information about said assets and to said inventory of said assets to the personal computer. (see column 3, lines 16-23)

9. Regarding claim 4, Subler discloses, creating a user profile based upon said user's inputs on the personal computer, and transmitting said user profile (see column 5, lines 55-64) and a unique indicia to said master server means; and said master server means is further for tailoring said updates based upon said user profile (see column 10, lines 54-63 and column 15, lines 20-42).
10. Regarding claim 5, Subler discloses, communication medium is a member of the set consisting of telephone systems, local area networks, and wide area networks (see column 4, lines 55-64)
11. Regarding claim 6, Subler discloses, communication medium is the Internet (see column 4, lines 55-64, wherein referring to Subler's reference to "Network Packets" as the Internet is called today, corresponds to above limitation).
12. Regarding claim 7, Subler discloses, wherein said client means stores said inventory in a storage means which includes at least one member of the set consisting of hard drives and removable media systems (see column 16, 28-32).

13. Regarding claim 8, Subler discloses, storage means includes a said removable media system and said removable media system is a member of the set consisting of CD drives, DVD drives, and magnetic tape drives (see column 16, 28-32 and lines 41-43).
14. Regarding claim 9, Subler teaches, wherein said storage means includes a said hard drive (see column 16, lines 28-32; clearly a Hard Drive can be used instead of the CD-ROM at the workstation) and a sector steal scheme is used in said digital wrappers protecting said assets (see column 2, lines 20-45 and column 9 line 65 bridging column 10, lines 10-26).
15. Regarding claim 10, Subler discloses, so that a said key issued to unwrap a said asset on a particular said storage means may not also be used to unwrap a same said asset present on a different said storage means (see column 4, line 56-66).
16. Regarding claim 11, Subler discloses, digital wrapper employs a member of the set consisting of key-required-activation and key-required-decryption (see column 10, lines 1-11).
17. Regarding claim 12, Subler discloses,

- a) providing on the personal computer a pre-stored inventory containing a plurality of assets, wherein said assets are instances of the digital content and are protected from unauthorized use by a digital wrapper requiring at least one key for unwrapping;(see column1, lines 5-6 and lines 62-63, column 7, lines 10-13, column 9, lines 32-48, and column 16, lines 20-27)
- b) displaying on the personal computer information about said inventory; (see column 3, lines 45-52)
- c) accepting from a user of the personal computer a selection representing a particular said asset; (see column 5, lines5-30)
- d) transmitting money representing payment for said selection and an identifier associated with said selection from the personal computer to a clearing house, via a communications system; (see column 3, lines 30-31 and column 4, lines 51-64)
- e) receiving at least one key associated with said selection at the personal computer; (see column 16, lines 20-26)
- f) unwrapping said digital wrapper protecting said selection using all said keys required for said selection. (see column 15, lines 49-56)

18. Regarding claim 13, Subler discloses,

- a. receiving at the personal computer a first said key from said clearing house (see column10, lines 2-5);

- b. transmitting from the personal computer said first said key to a master server, (see column 10, lines 5-11, column 15, lines 49-56 and column 18, lines 39-53) ; and
- c. receiving back at the personal computer a second said key (see column 10, lines 5-11, column 15, lines 49-56).

19. Regarding claim 14 and 17, it is rejected over Subler. The same rationale in rejecting claim 12 and 16 is being applied to claim 14 and 17, wherein step (b) through step (f) are performed using a graphical user interface presents said assets metaphorically as merchandise and unites of service in aisles of store. But what Subler teaches is, plurality of digital assets (items) displayed hierarchically organized graphical representations of items and groups of the items of digital information which are available to be ordered by a user (see column 1, lines 32-38 and column 3, lines 46-52).

20. Regarding claim 15 and 18, Subler teaches that the graphical user interface (see column 1, line 32-38 and column 3, lines 45-52) is embedded in the Suber's reference that different groups of items represent said graphical user interface further presents said stores metaphorically as a member of set consisting of aisles, stores, villages, town squares, shopping centers, and malls.

21. Regarding claim 16, Subler discloses, a client for marketing digital content on a personal computer, comprising:
- an infrastructure engine including a user interface and a communications interface (see column 1, lines 39-42 and lines 50-53, column 3, lines 16-18, and column 4, lines 38-65);
 - an inventory including a plurality of assets which are each instances of the digital content, wherein each said asset is protected from unauthorized use by a digital wrapper requiring at least one key for unwrapping (see column 2, lines 22-28, wherein the Subler discloses a plurality of encrypted digital assets stored within the workstation able to communicate with a central order taking system),
 - and storage means for containing said infrastructure engine and said inventory (see column 16, 28-32 and lines 41-43).
22. Regarding claim 19, Subler discloses, the client of claim 16, wherein said communications interface operates with at least one member of the set consisting of telephone systems, local area networks, and wide area networks (see column 4, lines 55-64).
23. Regarding claim 20, Subler discloses, the client of claim 16, wherein said communications interface operates with the Internet (see column 4, lines 55-

64, wherein referring to Subler's reference to "Network Packets" as the Internet is called today, corresponds to above limitation).

24. Regarding claim 21, Subler teaches, the client of claim 16, wherein said inventory is stored in said storage means in a hard drive (see column 16, lines 28-32; clearly instead of CD-ROM a hard drive in clients workstation can be used.) and said digital wrapper uses a sector steal scheme (see column 2, lines 20-45 and column 9 line 65 bridging column 10, line 1-26).

25. Regarding claim 22, Subler discloses, the client of claim 16, wherein said inventory is stored in said storage means in a removable media system and said digital wrapper uses a member of the set consisting of key required-activation and key-required-decryption (see column 10, lines 1-11).

26. Regarding claim 23, Subler discloses, the client of claim 16, wherein said inventory is stored in said storage means in a removable media system which uses a member of the set consisting of CD's, DVD's, and magnetic tape (see column 16, 28-32 and lines 41-43).

27. Regarding claim 24, Subler discloses, the [system] client of claim 16, wherein: said storage means includes a pre-stored and substantially unique indicia (see column 2, lines 34-41); and at least one said key is coded to work only

with said unique indicia, so that a said key issued to unwrap a said asset on a particular said storage means may not also be used to unwrap a same said asset present on a different said storage means (see column 4, line 56-66).

28. Regarding claim 25, Subler discloses, the client of claim 16, wherein said digital wrapper requires at least two said keys, so that multiple parties may each respectively and selectively control unwrapping of said assets (see column 10, lines 20-45).

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dolphin, U.S. Patent No: 5457746, System and method for access control for portable data storage media.

Chelliah et. al. U.S. Patent No: 5710887, Computer system and method for electronic commerce.

Levine et. al. U.S. Patent No: 5745681, Stateless shopping cart for the web.

Hellman, U.S. Patent No: 4658093, Software distribution system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-1396 for regular communications and (703) 308-1396 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

ka
December 7, 2001



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